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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/782,011   | 02/12/2001  | David Leigh Donoho   | UNIV0001D2-C        | 2182             |
| 22862  | 7590        | 05/13/2005           | EXAMINER            |                  |
| GLENN PATENT GROUP<br>3475 EDISON WAY, SUITE L<br>MENLO PARK, CA 94025 |             |                      | CARDONE, JASON D    |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 2145                |                  |

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/782,011

Applicant(s)

DONOHU ET AL.

Examiner

Jason D. Cardone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,5,7,9-12 and 14-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,7 and 9-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to the amendment of the applicant, filed on 12/22/04.

Claims 1, 5, 7, 9-12 and 14-19 are presented.

### ***Election/Restrictions***

2. Newly submitted claims 14-19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims do not disclose the inspector performs any of mathematico-logical calculations, executes computational algorithms, returns the results of system calls, accesses the contents of storage devices, and queries devices or remote computers. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14-19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Claims 1, 5, 7 and 9-12 are presented for further examination.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5, 7 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan, USPN 5,761,662, in view of Rose et al. (hereinafter Rose), UPSN 5,724,567.

6. Regarding claim 1, Dasan discloses a method for inspecting any of the properties computer's configuration, contents of said computer's storage devices, said computer's peripherals, said computer's environment, or remote affiliated computers, comprising the steps of: providing at least one inspector which includes an inspector library and associated methods [ie. user profiles, Dasan, col. 6, lines 1-19]; and evaluating subexpressions with said at least one inspector [ie. using user profile, Dasan, col. 6, lines 20-60];

Dasan does not specifically disclose the inspector performs any of mathematico-logical calculations, executes computational algorithms, returns the results of system calls, accesses the contents of storage devices, and queries devices or remote computers. However, Rose, in the same field of endeavor, discloses an inspector performs any of mathematico-logical calculations, executes computational algorithms, returns the results of system calls, accesses the contents of storage devices, and queries devices or remote computers [ie. server (10), Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate mathematico-logical calculations, taught by Rose, in to the newspaper generator, taught by Dasan, since Rose suggests that text retrieval for users, similar to the text retrieval disclosed by Dasan, can have the ability to direct relevant messages [Rose, col. 1, line 65 - col. 2,

line 16]. One of ordinary skill in the art would have been motivated to modify Dasan to include the mathematico-logical calculations in view of Rose, so that the user may see the most relevant message available.

7. Regarding claim 5, Dasan-Rose further discloses sending certain relevance clauses to a remote location; evaluating said clauses; and returning said clauses after a user is made aware of what is being transferred', wherein properties of said remote location are learned [Dasan, col. 6, lines 1-19] [Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

8. Regarding claims 7 and 9-12, claims 7 and 9-12 have similar limitations as disclosed in claims 1 and 5. Therefore, the similar limitations are disclosed under Dasan-Rose for the same reasons set forth in the rejection of claims 1 and 5 [Supra 1 and 5].

### ***Response to Arguments***

9. Applicant's arguments filed 12/22/04 have been fully considered but they are not persuasive.

10. (A) Rose fails to teach at least one inspector which performs any of performs any of mathematico-logical calculations, executes computational algorithms, returns the results of system calls, accesses the contents of storage devices, and queries devices or remote computers

As to point (A), Rose does disclose a correlation matrix within the server (inspector) for mathematico-logical calculations [Rose, col. 6, line 62 - col. 7, line 62]. The server of the invention of Rose, also, accesses contents of storage devices and queries devices or remote computers [Rose, col. 3, line 37 – col. 4, line 14]. During patent examination and prosecution, claims must be given their broadest reasonable interpretation. *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993); *In re Prater*, 415 F.2d 1393, 1404, 162 USPQ 541, 550 (CCPA 1969). Giving the instant claims their broadest reasonable interpretation, “an inspector performs any of” is broad enough to read on the server performing any of the functions that were listed as disclosed in Rose.

11. (B) Impermissible hindsight

As to point (B), in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate mathematico-logical calculations, taught by Rose, in to the newspaper generator, taught by Dasan, since Rose suggests that text retrieval for

users, similar to the text retrieval disclosed by Dasan, can have the ability to direct relevant messages [Rose, col. 1, line 65 - col. 2, line 16]. One of ordinary skill in the art would have been motivated to modify Dasan to include the mathematico-logical calculations in view of Rose, so that the user may see the most relevant message available.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

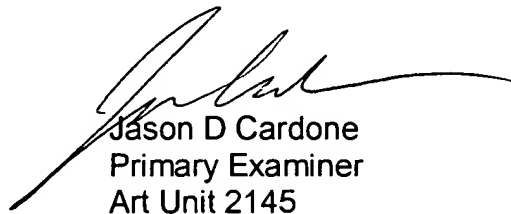
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D. Cardone whose telephone number is (571) 272-3933. The examiner can normally be reached on Mon.-Thu. (6AM-3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jason D Cardone  
Primary Examiner  
Art Unit 2145

May 3, 2005